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EXAMINER

SPENCER, WILLIAM C

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2675

DATE MAILED: 04/23/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

09/703,494

Applicant(s)

RYDBECK, NILS

Examiner

William C. Spencer

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002 and 29 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-20 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur, U.S. Patent no. 5,852,434, second embodiment.

As to claim 1, Sekendur discloses a pen in FIG. 7 for reading positional data FIGS. 1a-2 from a specially formatted surface FIG. 1. Optical detector 19 is disclosed within the pen. Pressure (force) sensitive switch 10 is connected to retractable writing element 9. In col. 5, lines 36-39, it is disclosed that during the process of writing, the surface is scanned, data is sent to a processor and analyzed, and output to a screen.

Sekendur does not disclose the function of switch 10. However, it is clear that it would be turned on when writing due to writing element 9 contacting the surface of FIG. 1. Therefore, it would have been obvious to one skilled in the art at the time of the invention to use switch 10 to determine when the process of writing is occurring for the purpose of determining when to scan the surface. Sekendur does disclose "override" switch 11, but the meaning of override is clearly not for default operation.

As to claim 2, Sekendur only discloses that the surface is scanned during writing, therefore it would have been obvious to one skilled in the art at the time of the invention that

Art Unit: 2675

scanning may be disabled when not writing. As would be appreciated by one skilled in the art, this could desirably reduce power consumption.

As to claim 7, the Examiner takes official notice that all mechanical responsive to pressure have a threshold pressure of activation.

As to claim 8, refer to the discussion of claim 1. The apparatus of Sekendur comprises a system for the electronic entry of information, since it outputs to a screen electronically. It comprises microcomputer 21. In col. 5, lines 33-34, it is disclosed that the dot 2 indicates an X-Y coordinate. Dot 2 is only one of many on the writing surface of FIG. 1.

3. Claims 3, 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur as applied to claim 1 above, and further in view of Lazzouni et al., U.S. Patent no. 5,652,412. Sekendur does not disclose a storage buffer, and the purpose of wireless transceiver 24 is not clear.

As to claim 3, Lazzouni discloses pen 10 for writing markings 12 and reading position from encoded paper 14 in FIG. 1. In FIG. 9, the image is captured at step 204 (and 208) only when the pen on paper is detected at step 200 (or 216). FIG. 11 discloses raw data buffer 262, decoder buffer 266, and results buffer 270 downstream from pen interface hardware 260. Col. 10, lines 46-48 discloses that hardware module 260 reads a detected signal. However, according to FIG. 9, the image is only captured when the pen on paper is detected. Therefore, it would have been obvious to one skilled in the art at the time of the invention that a comparison of FIGS. 9 and 11 concludes that buffer 262 does not receive raw data when the pen is not on the paper. The relation of the figures is somewhat unclear, so this may be an excessive restriction.

However, buffer 270 only receives decoded data, and valid decoded data requires the pen on the paper, so it would have been obvious to one skilled in the art at the time of the invention that results buffer 270, at the least, does not receive data when the pen is not on the paper.

In light of Lazzouni, it would have been obvious to one skilled in the art at the time of the invention to use a buffer or buffers to store data as part of the analysis process of Sekendur. Sekendur uses the switch 10 to detect when writing is occurring, so a buffer containing detected positional data would not have data stored to it when this sensor is not contacting the paper.

As to claim 4, Lazzouni discloses recording unit 20 for processing the signals of pen 10. In col. 4, lines 27-29, it is disclosed that a wireless communication may be used between pen 10 and recorder 20. As these units would otherwise be connected by cable 16, the communication is local.

In light of Lazzouni, it would have been obvious to one skilled in the art at the time of the invention that a local wireless link could be used to communicate the signals of the pen of Sekendur, or that transceiver 24 of Sekendur would be used for pen signal communication. The advantage of cable elimination in an input device is well known. As the pen of Sekendur includes processor 21, the output is decoded, so there would be no reason to transmit decoded data when no new decoded data is available. Therefore, it would have been obvious to one skilled in the art at the time of the invention to disable transmission when there is no positional data due to sensor 10 of Sekendur not being in contact with the paper, in order to save power.

As to claim 15, a modification of Sekendur in view of Lazzouni would use the methods discussed in reference to claim 3 above.

4. Claims 1, 3, 5, 8, 15-17 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al., U.S. Patent no. 5,652,412, in view of Sekendur, first and second embodiments. As to Lazzouni and Sekendur, refer to above discussion.

As to claim 1, in comparison of Lazzouni with Sekendur, it is glaringly apparent that Lazzouni refers to detecting the pen on the paper, but discloses no special switch or means of this detection. This would have made it obvious to consider other means of contact detection. Although it conflicts somewhat with Lazzouni FIG. 9, it would have been obvious to one skilled in the art at the time of the invention that the inability to resolve or detect an image would indicate no contact. While this is slightly more complicated to process than providing a switch, it does offer an advantage of no moving parts. In this case, the optical reading system (see Lazzouni col. 5, line 8) would act as the contact sensor.

As to claim 5, Lazzouni does not disclose a retractable writing means. In light of Sekendur, it would have been obvious to one skilled in the art at the time of the invention to modify the invention of Lazzouni to provide a retracting means. In this case, since no switch is used, contact detection would be provided at all times.

Sekendur's second embodiment does not disclose scanning when the pen is retracted. In col. 6, lines 8-11, describing the first embodiment, Sekendur discloses modes of the writing element being retracted or not, and the possibility of scanning in all modes. It would have been obvious to one skilled in the art at the time of the invention that this advantage could also be brought to the second embodiment (actually, placement of this disclosure of the multiple modes is the only reason to consider that these modes were intended to be specific to the first

Art Unit: 2675

embodiment). Therefore, this limitation of Sekendur's second embodiment would not affect the above-described modification of Lazzouni.

As to claims 3, 8 and 23, refer to above discussion.

As to claim 15, a modification of Lazzouni in view of Sekendur would use the methods discussed in reference to claim 3 above.

As to claim 16, Sekendur discloses that writing means 9 is retractable. As to claim 17, it would have been obvious to one skilled in the art at the time of the invention that the retracted option could be selected.

5. Claims 9-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur as applied to claim 8 above, and further in view of Wolff et al., UK Patent Application GB2306669A. Sekendur does not disclose use of the system with paper preprinted with an entry field.

As to claim 9, Wolff discloses a system using pen instrument 91 for writing on an ordinary document (p. 3, line 3) or special documents such as Calendar Book (CB) page 10 in FIG. 6. If it is needed to identify a specific type of a special document, bar code 13 is used in conjunction with optical sensor 220. In p. 22, lines 5-8, it is disclosed that CCD 260 can identify local context within a document by identifying printed marks, although pen instrument 91 generally utilizes position sensor 210 and pressure sensors 100 to determine location within a page. FIG. 1 discloses an example 20 of a calendar book page. Page 20 is preprinted with columns of rectangles 22, 22' and other spaces for writing associated with time of day, with examples of handwriting and checkmarks shown.

In light of Wolff, it would have been obvious to one skilled in the art at the time of the invention to modify the formatted writing surface of Sekendur to include preprinted entry fields. While Sekendur discloses mainly hardware, Wolff discloses many uses for the pen instrument 91 which clearly could be useful in the case of other types of pen instruments as well. Besides, preprinted forms are well known for conventional handwriting entry and/or electronic entry (such as the attached Office Action Summary) and it would be excessively limiting to consider the system of Sekendur useless for such well-known documents.

As to claim 10, Wolff discloses bar code 13 for identifying the type of document. However, Sekendur discloses electronically-readable information over the entire specially formatted page. In light of this, it would have been obvious to one skilled in the art at the time of the invention to include identifying information for the type of document in the electronic information distributed over the page. Sekendur discloses additional information capacity beyond X and Y coordinate information, document identification is clearly needed for specialized document use, and use of a separate bar code in the manner of Wolff would be redundant and inconvenient in a modification of Sekendur.

As to claim 11, both Wolff and Sekendur disclose character recognition based on a plurality of detected pen positions. In Wolff, this is converted into entry of data into an electronic counterpart of the document (for example, see p. 6, lines 9-13).

As to claim 13, a calendar book is a type of personal information management.

As to claim 14, Wolff discloses a means of setting desired forwarding locations in an electronic fax system in p. 6, line 21 through p. 7, line 4. It would not have been reasonable to expect that this forwarding location could have been written just anywhere on the document, so it



Art Unit: 2675

would have been obvious to one skilled in the art at the time of the invention that a space for writing the forwarding location would have to be provided. Wolff also discloses non-writing functions, such as control of lights in p. 4, lines 1-3, and use as a mouse in p. 25, line 21 through p. 26, line 2. Sekendur also compares the system to a mouse. Therefore, it would have been obvious to one skilled in the art at the time of the invention to find ways to provide all mouse capabilities.

6. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni in view of Sekendur as applied to claim 8 above, and further in view of Wolff. Claims 18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni in view of Sekendur as applied to claims 15 and 17 above, and further in view of Wolff. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni in view of Sekendur as applied to claim 23 above, and further in view of Wolff.

Refer to above discussions.

#### ***Allowable Subject Matter***

Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Applicant argues with regards to the purpose of pressure sensitive switch of Sekendur. On page 9, lines 17-19 of the remarks, it is asserted that switch 10 is located on the outside of the

Art Unit: 2675

conduit 8 where it may be pressed by the user in both FIGS 6 and 7. However, in FIG. 7, the switch 10 is clearly on the inside of conduit 8. Both ink cartridge 9 and switch 10 are shown in dotted lines except where conduit 8 is shown in cutaway form. Besides, an ink cartridge retraction button would not normally be called a "pressure sensitive switch." This language is far more appropriate to an electrical switch.

An electrical switch with moving mechanical parts always requires crossing a predetermined force threshold to activate, in this Examiner's experience.

While Sekendur is brief with regards to the switch, one skilled enough in the art to make use of Sekendur's disclosure would find use of it in the ways considered obvious in the Rejection to be trivial.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Spencer whose telephone number is 703-306-5842.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras can be reached on 703-305-9720.

**Any response to this action should be mailed to:**


Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is 703-306-0377.

  
STEVEN SARAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600